

## REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

After entry of the foregoing amendment, Claims 1-2 and 4-6 remain pending in the application. Claim 3 has been cancelled as its subject matter has been incorporated into Claim 1 as amended. The remaining amendments to Claims 1-2 and 4-6 have been made to place the claims in a more acceptable form for U.S. practice. As such amendments have simply been a manner of form, cosmetic in nature, it is respectfully submitted the scope of these claims has not been narrowed.<sup>1</sup> No new matter has been added by the amendment.

By way of summary, the Official Action presents the following issues:

The specification has been objected to as lacking an Abstract; Claims 1-2 and 5-6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Timm et al (U.S. Patent 5,687,215, hereinafter "Timm", in view of Joong et al (U.S. Patent 5,937,355, hereinafter "Joong"; and Claims 3-4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Timm in view of Joong and in further view of Alperovich et al (U.S. Patent 6,014,568, hereinafter "Alperovich").

As the subject matter of dependent Claim 3 has been incorporated into independent Claim 1, Applicants will address the rejection of Claim 3 as outlined in paragraph 7 of the Official Action with respect to Claim 1. Applicants submit that the rejection of Claim 1, as outlined in paragraph 6 of the Official Action, has been rendered moot by the foregoing amendment.

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<sup>1</sup> This comment has been made in view of the recent Festo decision which may limit the availability of the Doctrine of Equivalents, for narrowing amendments for patentability reasons.

REJECTION UNDER 35 U.S.C. § 103

The Official Action has rejected Claims 1 and 4 under 35 U.S.C. § 103 as being unpatentable over Timm in view of Joong and in further view of Alperovich. The Official Action states that the combination of Timm and Joong disclose all the Applicants' claim limitations with the exception of the transmission of position specification data at the cell level via a general cell broadcast message. The Official Action cites Alperovich as teaching this more detailed aspect of the Applicants' invention and states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Alperovich with that of Timm and Joong to arrive at the Applicants' claim limitations. Applicants respectfully traverse the rejection.

Amended Claim 1 recites, *inter alia*, a method to transmit position specification in a mobile telephone system, including base stations and mobile stations including:

". . . transmitting a position specification to a mobile station which stores the position specification, the position specification being transmitted out on cell level via a general (cell broadcast; CB) message . . ."

By way of background, it is known to equip individuals and/or vehicles with mobile telecommunications devices for enabling the exchange of telecommunication data. Heretofore, position data regarding the location of the mobile telecommunications device is provided either by voice communication of the user or by the relay of a global positioning system data (GPS) to a suitable receiver of the mobile device. Yet, these methods often prove inefficient and costly to implement as user information is often unreliable in emergency situations and GPS data is cost prohibitive to enable and process for most applications. In light of the above deficiency in the art, the present invention is provided. With this object in mind, a brief comparison of the claimed invention in view of the cited references is believed to be in order.

Timm discloses a vehicular emergency message system. The system includes vehicle hardware (10) which is designed to communicate with system infrastructure (11).<sup>2</sup> The infrastructure includes GPS satellites (12), cellular towers (13), and plain old telephone system (POTS) lines (14). The vehicle hardware includes a GPS receiver (21) and a cellular transceiver (22). The GPS receiver collects positional data from satellites for storage in a local memory of the vehicle hardware (10). Upon initiation of a transmission between the vehicle hardware and the cellular towers, data is relayed to the response center such as the last obtained position from a GPS receiver in terms of latitude and longitude.<sup>3</sup>

Likewise, Joong discloses an emergency call cellular telecommunications system in which GPS data is relayed to an emergency message center (MSC) to locate a telecommunication terminal. The GPS data may be relayed via a short message service (SMS).<sup>4</sup>

Alperovich discloses a wireless telecommunications system in which a voice coder selection is based on the location of the describer. A location is identified relative to a network cell based on information provided from the short message system (SMS). This location is not RELAYED to a center upon dialing a specific call, merely employed as a variable in determining voice coding.

As can be appreciated, both Timm and Joong are directed toward global positioning system location techniques for use in a mobile telecommunications device such as a cellular phone. As can be appreciated, these costly and often complex designs are not suitable for every day application as the inclusion of GPS receiver hardware and processing circuitry is

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<sup>2</sup>Timm at Figure 1; column 2, lines 50-53.

<sup>3</sup>Timm at column 6, lines 24-26.

<sup>4</sup>Joong, column 3, lines 27-44.

costly. Thus, these references teach away from the Applicants' simplistic approach in determining a location relative to a network cell configuration.

"A reference may be said to teach away when a person of ordinary skill in the art, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). To this end, "disclosures in the references that diverge from and teach away from the invention cannot be disregarded", Phillips Petroleum Company v. U.S. Steel Corp., 9 USPQ2d 1461 (Fed. Cir. 1989).

While Alperovich discloses the provision of data to a mobile terminal via the short message system (SMS) and storing this data in the subscriber identity module (SIM) for selecting a voice coder relative to the location of the mobile terminal in the cell network, applying this isolated teaching in combination with the above references which clearly teach away from the Applicants' solution, can only be based on hindsight reconstruction in view of the Applicants' disclosure. Moreover, the use of Alperovich's SMS data in combination with the Timm and Joong references would serve no useful function as these devices already employ GPS technology for identifying a location.

In this respect, it is well established by In re. Warner, 154 USPQ 173, 178 (CCPA 1967) that:

"A rejection based on § 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, all facts must be considered. The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis."

Accordingly, as Applicants' invention as presently recited in Claim 1 as amended is not disclosed or suggested by the combination of references discussed above, Applicants respectfully request that the rejection of Claim 1 under 35 U.S.C. § 103 be withdrawn. Similarly, as Claims 2 and 4-6 are directly and/or indirectly dependent upon Claim 1, Applicants respectfully submit that these claims are likewise allowable, at least for the reasons discussed above.

#### CONCLUSION

Consequently, in view of the foregoing amendment and remarks, it is respectfully submitted that the present application, including Claims 1-2 and 4-6, is patentably distinguished over the prior art, is in condition for allowance, and such action is respectfully requested at an early date.

Respectfully submitted,

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IN THE CLAIMS

--1. (Amended) A method [Procedure] to transmit position specification in a mobile telephone system including base stations and mobile stations, [characterized in] comprising the steps of:

[- that] transmitting a position specification [is transmitted] to a mobile station which stores the position specification, the position specification being transmitted out on cell level via a general (cell broadcast; CB) message;

[- that] making a specific telephone call [is made] from the mobile station to a [centre] center which has a receiving terminal;

[- that] triggering the [specific call triggers off that] transmission of the position specification [is] collected [and is transmitted] in a separate message to the [centre] center upon making the specific telephone call;

[- that] transmitting the position specification [is transmitted] via short text message (SMS) to the [centre] center, which by A-number-[analyse]analysis identify where to route the SMS-message and verbal contact is connected to the same operator in the [centre] center, and the operator [identify] identifies the area from which the mobile station calls.

2. (Amended) [Procedure as claimed in patent] The method of claim 1, [characterized in that] wherein the telephone call and the message both include information

about the subscriber number of the mobile station, so that the message is routed to the same receiving terminal.

3. (Canceled).

4. (Amended) [Procedure as claimed in] The method of [claims] claim 1,  
[characterized in that] wherein the position specification is stored in an application on the mobile station's subscriber card (SIM).

5. (Amended) [Procedure as claimed in] The method of [claims] claim 1,  
[characterized in that] wherein the message is of the type short text message (SMS) or USSD (Unstructured Supplementary Services Data) or UUS (User-to-User Signalling).

6. (Amended) [Procedure as claimed in] The method of [claims] claim 1,  
[characterized in that] wherein the telephone call is an emergency call, and the [centre] center  
is an emergency [centre] center.--